

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-45 are pending in the application. Claims 13-15 and 28-45 are withdrawn from consideration due to a restriction. Among the claims that are not withdrawn, claims 1 and 16 are the independent claims. Claims 1-4, 12, 16, 17, 19 and 27 are sought to be amended. More specifically, claims 2-4, 17, and 19 are sought to be amended to correct antecedent basis only and not to amend around any prior art. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Restriction Requirement

Applicants affirm the provisional election made without traverse on July 28, 2005 in a telephone conference between the Examiner and Jeffrey S. Weaver, attorney for the Applicants, to prosecute the invention of Group I, claims 1-12 and 16-27. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

Priority

The Examiner has noted that the present application 09/864,293 is a Continuation-In-Part (CIP) of Applications 09/559,964 and 09/393,390. The Examiner has alleged that this Application, 09/864,293, does not benefit from an earlier filing date of Applications 09/559,964 and 09/393,390 due to inadequate support. (See Office Action, page 3). Applicants respectfully disagree with the Examiner. But, since there is no issue pending requiring a resolution of priority, Applicants deem Examiner's allegation as being moot and/or premature. Applicants reserve the right to defend and assert the benefit of an earlier filing date for this Application at a later time when an issue regarding priority becomes ripe.

Rejections under 35 U.S.C. § 112

The Examiner has rejected claims 12 and 27 under 35 U.S.C. § 112, second paragraph, as being indefinite. (See Office Action, page 4). Specifically, the Examiner has alleged that the terms "provider" and "server" are unclear. (See Office Action, page 4).

The Applicants have amended claims 12 and 27 to further clarify the claimed invention. In light of the amendments sought to claims 12 and 27, Applicants believe the Examiner's rejections under 35 U.S.C. § 112 are moot and/or invalid. Therefore, Applicants respectfully request that the rejections under 35 U.S.C. § 112 be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 4, 6, 7, 9-11, 16, 17, 19, 21, 22, 24-26

The Examiner has rejected claims 1, 2, 4, 6, 7, 9-11, 13-17, 19, 21, 22 and 24-26 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 6,516,341 to Shaw *et al.* ("Shaw"). (See Office Action, page 4). Since claims 13-15 are subject to a restriction and since the Examiner has not provided reasons for rejecting claims 13-15, Applicants assume that the inclusion of claims 13-15 as allegedly being unpatentable over Shaw has been made in error. Applicants assume that the Examiner intended to reject claims 1, 2, 4, 6, 7, 9-11, 16-17, 19, 21, 22 and 24-26 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw. Although the Applicants respectfully disagree with the Examiner's allegations, Applicants believe these rejections are incorrect and/or moot in light of the above amendments.

For the Examiner's convenience, independent claim 1 as amended is recited below.

1. A computer implemented method for placing advertisements with interactive content on devices, comprising the steps of:
 - (1) **displaying an advertisement with interactive content on a device, wherein the advertisement is at least a portion of a web page adapted for the device;**
 - (2) pre-populating at least one field of the advertisement with address location information relating to the user of the device; and
 - (3) conditionally forwarding the at least one pre-populated field to an entity associated with the advertisement to provide information regarding the user to the entity.

Shaw does not teach or suggest each and every element, limitation, and/or feature of amended independent claim 1. Shaw is directed towards an email and advertising system for use with a computer that connects to an email server intermittently via a modem. (See Shaw, abstract). As Shaw is directed towards providing a user with access to email and advertisement while the user's computer is offline rather than providing advertisements tailored for particular devices, Shaw does not contemplate that advertisements should be adapted for differences in devices (e.g., memory limitations, screen size, etc.). Hence, Shaw does not teach or suggest, for example, "displaying an advertisement with interactive content on a device, wherein the advertisement is at least a portion of a web page adapted for the device." Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1, and allowance thereof.

Claims 2, 4, 6, 7 and 9-11 depend from independent claim 1 and are patentable for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2, 4, 6, 7 and 9-11, and allowance thereof.

Shaw does not teach or suggest each and every element, limitation, and/or feature of amended independent claim 16. For example, Shaw does not teach or suggest "displaying means for enabling a processor to display an advertisement with interactive content on a device, wherein the advertisement is at least a portion of a web page adapted for the device." For at least the reasons stated above, claim 16 is patentable over Shaw. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 16, and allowance thereof.

Claims 17, 19, 21, 22 and 24-26 depend from independent claim 16 and are patentable for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 17, 19, 21, 22 and 24-26, and allowance thereof.

Claims 3, 5, 18, 20

The Examiner has rejected claims 3, 5, 18 and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw and U.S. Patent 6,794,210 to Goldhaber *et al.* ("Goldhaber"). (See Office Action, page 7). Although the Applicants respectfully disagree, Applicants believe these rejections are incorrect and/or moot in light of the above amendments.

Goldhaber and Shaw, alone or in combination, do not teach or suggest each and every element, limitation, and/or feature of claims 3, 5, 18 and 20. Claims 3 and 5 depend from independent claim 1. Claims 18 and 20 depend from independent claim 16. With respect to independent claims 1 and 16, Goldhaber fails to overcome the deficiencies of Shaw. For example, Goldhaber does not teach or suggest "wherein the advertisement is at least a portion of a web page adapted for the device." Hence, claims 3, 5, 18 and 20 are patentable over Goldhaber and Shaw, alone or in combination, for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3, 5, 18 and 20, and allowance thereof.

Claims 8, 23

The Examiner has rejected claims 8 and 23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw and U.S. Patent 6,332,127 to Bandera *et al.* ("Bandera"). (See Office Action, page 7). Although the Applicants respectfully disagree, Applicants believe these rejections are incorrect and/or moot in light of the above amendments.

Bandera and Shaw, alone or in combination, do not teach or suggest each and every element, limitation, and/or feature of claims 8 and 23. Claim 8 depends from independent claim 1. Claim 23 depends from independent claim 16. With respect to independent claims 1 and 16, Bandera fails to overcome the deficiencies of Shaw. For example, Bandera does not teach or suggest "wherein the advertisement is at least a portion of a web page adapted for the device." Hence, claims 8 and 23 are patentable over Bandera and Shaw, alone or in combination, for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 8 and 23, and allowance thereof.

Claims 12, 27

The Examiner has rejected claims 12 and 27 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw and U.S. Patent 5,933,811 to Angles *et al.* ("Angles"). (See Office Action, page 8). Although the Applicants respectfully disagree, Applicants believe these rejections are incorrect and/or moot in light of the above amendments.

Angles and Shaw, alone or in combination, do not teach or suggest each and every element, limitation, and/or feature of claims 12 and 27. Claim 12 depends from independent claim 1. Claim 27 depends from independent claim 16. With respect to independent claims 1 and 16, Angles fails to overcome the deficiencies of Shaw. For example, Angles does not teach or suggest "wherein the advertisement is at least a portion of a web page adapted for the device." Hence, claims 12 and 27 are patentable over Angles and Shaw, alone or in combination, for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 12 and 27, and allowance thereof.

Other Matters

Applicants acknowledge with appreciation the Examiner's previous consideration of the documents submitted by Applicants in Information Disclosure Statements (IDS) in the present application on the respective dates of September 19, 2001, August 31, 2004, and January 19, 2005. Applicants note that additional documents have been submitted to the USPTO in a First Supplemental IDS filed on April 3, 2002, a Second Supplemental IDS filed on August 21, 2003, and a Third Supplemental IDS filed on February 18, 2004. Thus, Applicants respectfully request that the Examiner provide an indication of the Examiner's consideration of these documents in a future communication.

Conclusion

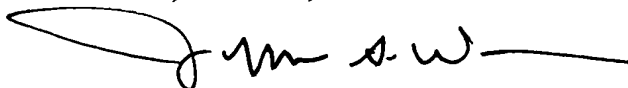
All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19 0036.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "J. M. S. W.", followed by a horizontal line.

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